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| APPLICATION NO.                      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--------------------------------------|-------------|----------------------|-------------------------|------------------|
| 10/085,442                           | 02/28/2002  | Kristi Cordova       | 100110485-1             | 1846             |
| 7590                                 | 01/13/2006  |                      | EXAMINER                |                  |
| HEWLETT-PACKARD COMPANY              |             |                      | BADI, BEHRANG           |                  |
| Intellectual Property Administration |             |                      | ART UNIT                | PAPER NUMBER     |
| P.O. Box 272400                      |             |                      |                         | 3621             |
| Fort Collins, CO 80527-2400          |             |                      | DATE MAILED: 01/13/2006 |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/085,442             | CORDOVA, KRISTI     |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Behrang Badii          | 3621                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 October 2005.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Arguments***

Applicant's arguments filed 10/19/05 have been fully considered but they are not persuasive.

**2112 [R-3] Requirements of Rejection Based on Inherency; Burden of Proof**

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

It is inherent that the content is stored under the control of the user/content requester. This content must be under the control of the user in order for the user to have access to it while using an electronic license or key to be able to use the content.

Furthermore, Fransdonk discloses content/software stored under the control of the user (p 350, 404, 179, 239, 216 and 317).

An electronic deliver address and/or a network address is inherent in any network based operation. Further, Fransdonk discloses an electronic delivery address (p22) and a network address (claim 30 and 41, p22).

In response to applicant's arguments, the recitation "stored under the control of the user" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it

merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Fransdonk, U.S. patent application publication 2003/0165241.

As per claim 1, Fransdonk discloses a method of delivering an electronic license and unlocking electronic files for the purpose of using software stored under the control of a user (abstract), said method comprising the steps of:

accepting from said user a request for a code to unlock specific ones of said stored electronic files (The user requests contents that includes a key for decrypting. Abstract, p140, 180 & 241);

processing accepted ones of said requests; said processing including obtaining an electronic delivery address for said user and verifying the availability to said user of

said requested code (The system obtains a address (URL), authenticates the user and sends the requested content, including the address) to the user); and

electronically delivering to said electronic delivery address the address of at least one network access destination, such that said requesting user can electronically access said network access destination to obtain a said code for unlocking said specific electronic file (The system sends the address (URL) to the user and the user can obtain the requested content, including the key by having a secure session with the address included. P82-83, 98 & 164).

As per claim 2, Fransdonk discloses wherein said accepting step can be accomplished by several different parties (p55, 208, abstract & 232).

As per claim 3, Fransdonk discloses wherein said processing step can be accomplished by several different parties (p208, 55, abstract & 232).

As per claim 4, Fransdonk discloses wherein said code is also unique to a particular user and wherein said network access destination is a specific URL, said URL delivered to said user by said electronically delivering step (p82-83, 98 & 164).

As per claim 5, Fransdonk discloses wherein said code is unique to one or more particular machines on which said electronic files may reside (p82, 230 & 250).

As per claim 6, Fransdonk discloses wherein said code is unique to a particular storage medium (p98, 309, 315).

As per claim 1, Fransdonk discloses wherein said code is unique to a particular storage location (p98, 309, 315).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cronce (U.S. patent application publication 2003/0156719) discloses a delivery of a secure software license for a software product and a toolset for creating the software product.

Tokutani et al. (U.S. patent application publication 2004/0139315) discloses Private data protection distribution method and program.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Behrang Badii whose telephone number is 571-272-6879. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**or faxed to (571)273-8300**

Hand delivered responses should be brought to

United States Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is **(571) 272-3600**.

Behrang Badii  
Patent Examiner  
Art Unit 3621

BB

*Behrang Badii*  
PRIMARY EXAMINER